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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 09/800,826 | 03/08/2001 | Alex Nadezhdin | AML/11665.33 | 3651 |
| 25545 | 7590 | 12/10/2003 | EXAMINER | |
| GOUDREAU GAGE DUBUC 800 PLACE VICTORIA, SUITE 3400 MONTREAL, QUEBEC, H4Z 1E9 CANADA | | | CHEVALIER, ALICIA ANN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1772 | |

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

0014

Office Action Summary

Application No.

09/800,826

Applicant(s)

NADEZH DIN ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-22, 37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 12-22 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

RESPONSE TO AMENDMENT

Note to Applicant: In the current listing of claims, Applicant has listed claims 23-36 as withdrawn. This is incorrect. Claims 23-36 were canceled in amendment A, paper #7 filed August 6, 2002. Appropriate correction is required in all subsequent actions.

REJECTIONS REPEATED

1. The 35 U.S.C. §103 rejections of claims 1-6, 10 and 37 are repeated for reasons previously of record in paper #8, pages 2-4, paragraphs #4-6, as repeated below.
2. The 35 U.S.C. §103 rejections of claims 1, 4, 5, and 37 over Winter, IV (5,224,315) in view of Spively (6,173,540) are repeated for reasons previously of record in paper #8, pages 2-3, paragraph #4.

Winter discloses a prefabricated building panel comprising an inner skin layer, a multi-layered core, and an outer skin layer (figure 1). The inner and outer skin layers may comprise oriented strand board (col. 6, lines 24-31). The middle layer of the multi-layers core comprises a paper honeycomb (perforated mat) (col. 8, lines 17-21), which has voids having boundaries that are essentially orthogonal to the skin layers. Selection of the relative voids by volume in the broad ranges claimed is taken as being within the ordinary skill of the art absent unexpected results.

The prefabricated building panel is used for wall, roof, and floor paneling (col. 1, lines 16-17).

Winter fails to disclose the composition of the oriented strand board.

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Spivey discloses an oriented strand board used for a stair tread panel comprising a cut wood strips mixed in a phenolic resin (col. 2; lines 45-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the oriented strand board of Spivey as the oriented strand board of Winter. One of ordinary skill would have been motivated to do so in order to give Winter's paneling a wood appearance.

Furthermore, since the combination of Winter and Spively discloses all the limitations of claim 1, the core would be capable of being compression-resistant in a direction essentially orthogonal to said plane defined by said first oriented strand face.

Regarding applicant's new limitation "single press OSB panel." The limitation is a process limitation. The method of forming the product is not germane to the issue of patentability of the product itself. Furthermore, for a process limitation to be given weight in a product claim it must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

3. The 35 U.S.C. §103 rejections of claims 2 and 3 over Winter, IV (5,224,315) in view of Spively (6,173,540) and further in view of Medawar (3,815,215) are repeated for reasons previously of record in paper #8, pages 3-4, paragraph #5.

The combination of Winter and Spively disclose all the limitation of the instant claimed invention except for the core comprising an inorganic filler.

Medawar discloses a honeycomb structural panel for walls, etc. The structural panel comprises two skin layers sandwiched around a honeycomb core (figure 1). The honeycomb layer is filled with a filler material comprising a mixture of an epoxy resin and calcium carbonate

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(col. 4, lines 14-19) to prevent lateral distortion and column failure (col. 2, lines 22-23).

Selection of the relative weight percent of inorganic filler in the broad ranges claimed is taken as being within the ordinary skill of the art absent unexpected results

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the filler material of Medawar to the honeycomb layer of Winter. One of ordinary skill would have been motivated to add the filler material to Winter in order to help prevent lateral distortion and/or column failure.

4. The 35 U.S.C. §103 rejections of claims 6 and 10 over Winter, IV (5,224,315) in view of Spively (6,173,540) and further in view of Haywood (3,895,997) are repeated for reasons previously of record in paper #8, page 4, paragraph #6.

The combination of Winter and Spively disclose all the limitation of the instant claimed invention except for the core made of paper mill sludge.

Haywood discloses recycling paper mill sludge (paper waste) to be useful in different types of paneling boards, see whole document.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use paper mill sludge as taught by Haywood to make the paper honeycomb core of Winter. One of ordinary skill would be motivated to use the paper mill sludge as the paper material of Winter's honeycomb because using recycled material would be cheaper.

ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments filed in paper #13, filed July 3, 2003, regarding the 35 U.S.C. §103 rejection over Winter, IV (5,224,315) in view of Spively (6,173,540) have been carefully considered but are deemed unpersuasive.

Applicant argues that no mention is made in Winter or Spivey of fabricating the composite panel in a single press cycle. The limitation "single press" is a method of forming the OSB panel. The method of forming the product is not germane to the issue of patentability of the product itself.

When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113.

Furthermore, for a process limitation to be given weight in a product claim it must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Applicant concedes on page 7, lines 10-15, that the combination of Winters and Spivey disclose all the claimed structural features of instant claim 1. Since, the process limitation does not result in a "structural difference," the prior art product and the instant claim product are considered to be the same.

Applicant further argues that the references do not disclose the necessity that the core be sufficiently compression resistant to withstand the pressure brought to bear in a single press

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cycle. First, there are no limitations directed to the compression resistance stated in the claims. Second, even if the limitation was in the claims, the specification does not disclose what is considered to be sufficiently compression resistant to withstand the pressure brought to bear in a single press cycle.

Applicant further arguments deal with the comparative data shown in the specification, which is not commensurate in scope with the prior art of record. The comparative examples shows the instant claimed invention compared to an OBS panel with a core layer having conventional flat wood flakes. The comparative data shows that the claimed OBS panel has better having modulus of elasticity and modulus of rupture than the conventional OBS panel with a flat wood flakes core. The prior art or record has a core comprising a honeycomb having voids, not flat wood flakes. There are no comparative examples showing an OBS panel with a core comprising a honeycomb having voids made by conventional laminating process. Therefore, Applicant is unable to show unexpected results over the prior art of record.

6. Applicant's arguments filed in paper #13, filed July 3, 2003, regarding the 35 U.S.C. §103 rejection over claims 2, 3, 6 and 10 have been carefully considered but are deemed unpersuasive.

Applicant argues that claims 2, 3, 6 and 10 are allowable for the same reasons regarding the rejection over Winter in view of Spivey. Applicant's arguments regarding the combination of Winter and Spivey have already been addressed above.

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays


If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official papers is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

12/9/03

A handwritten signature in black ink, appearing to be 'AC', is written over the date '12/9/03'.


SANDRA M. NOLAN
PRIMARY EXAMINER